

REMARKS/ARGUMENTS

Applicant has carefully reviewed the present application in light of the April 9, 2004 Office Action, wherein claims 1 and 12 were rejected under U.S.C. § 112; claims 1, 3-8, 16, 18 and 19 were rejected under U.S.C. § 102(b) as being anticipated by Yang (U.S. Patent No. 4,584,621); and claims 2, 9-15 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang in view of Gershen et al. (U.S. Patent No. 5,583,730). In response, Applicant has amended claims 1, 10 and 16 and has canceled claims 2, 11 and 17. Re-examination and reconsideration of the Application is respectfully requested.

SPECIFICATION OBJECTIONS

Page 6, lines 6 and 9 have been corrected per the Examiner's suggestion.

CLAIM REJECTIONS

Claims 1-15 were rejected under 35 U.S.C. § 112. Applicant has amended independent claims 1 and 10 so that two different elements are not referred to by the same name. Accordingly, Applicant believes that this rejection has been overcome.

The §102 rejections no longer apply as the recitations of claim 2 have been incorporated into claim 1, and the recitations of claim 17 into 16.

Claims 2, 9-15 and 17 were rejected in the Office Action as being obvious in view of the combination of Yang and Gershen. Based upon the foregoing claim amendments and the following remarks, Applicant respectfully contends that the obviousness rejection cannot be established by modifying Yang in view of Gershen, in the manner described in the Office Action.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in

the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. § 2143 (citing In re Vaeck, 20 USPQ 2d 1438 (Fed.Cir. 1991)).

Applicant respectfully asserts that there is no suggestion or motivation to combine the Yang and Gershen references.

In Ruiz v A.B. Chance Co., 234 F.3d 654 (Fed. Cir. 2000), it was held that "while the references need not expressly teach that the disclosure contained therein should be combined with another, see Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability must be "clear and particular." In re Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. [Emphasis added]. In the instant office action, the showing of combinability is far from "clear and particular."

"For a proper obviousness combination, the prior art references must provide a suggestion or motivation to make such a combination." Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc., 21 F.3d 168, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) citing Northern Telecom Inc. v. Datapoint Corp., 908 F.2d 931, 934 15 USPQ2d 1321, 1323 (Fed. Cir. 1990).

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, "teachings of references can be combined only if there is some suggestion or incentive to do so." Id.

Thus, for an obviousness combination, the "critical inquiry is whether 'there is something in the prior art as a whole to suggest the desirability, and thus the obviousness of making the combination.'" Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985) quoting Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1453, 1452, 221 USPQ 481, 488 (Fed. Cir. 1984). In other words, the "mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) citing Carl Schenck, A.G. v. Nortron Corp., 713 F.2d 782, 787, 218 USPQ 698, 702 (Fed. Cir. 1983).

Yang is directed to a multi-pole switch which sequentially opens or closes pairs of contact points to limit arcing. In contrast, Gershen is related to a shock hazard protection system which disconnects an electrical load from the electrical source when a shock hazard condition exists within the load, and is designed to be contained within a plug of the electrical apparatus. Thus, Gershen et al. is not directed to an electrical switch. Therefore, Applicant contends that Gershen discloses nothing to indicate to one of ordinary skill of the art that it would be desirable to incorporate the features of Gershen into Yang.

Furthermore, the "statute, § 103, requires much more, i.e., that it would have been obvious to produce the claimed invention at the time it was made without the benefit of hindsight." Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1575, 1 USPQ2d 1081, 1087 (Fed. Cir. 1986). "When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) citing ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577 & n.14, 221 USPQ 929, 933 & n.14 (Fed. Cir. 1984).

Due to the non-analogous nature of the Gershen and Yang references, Applicant believes that the only suggestion that Yang should be modified in the manner proposed in the Office Action comes solely from Applicant's own disclosure.

Aside from the fact that the references are non-analogous and do not suggest to one skilled in the art to arrive at the present invention, the present invention, as recited in the independent claims, is structurally distinct from the disclosure of the two cited references. As recited in amended independent claim 1, the switch assembly includes a non-conductive shield between the first line switch and the second line switch for preventing magnetic induction of current. In the Office Action, it is asserted that Gershen teaches such a shield to electrically separate the first live switch and the second live switch. However, this is simply not the case. Element 664 in Figure 10 is actually a metallic frame. Gershen discloses, beginning at column 10, line 66, that frame 664 comprises part of the magnetic circuit associated with the operating winding or coil 672 and for that purpose encloses a portion of the coil. Thus, the frame 664 of Gershen is not a shield disposed between the first line switch and the second line switch for preventing magnetic induction of current. Instead, Gershen discloses a conductive frame which comprises part of the magnetic circuit. This teaching is completely contrary to that of the present invention.

Dependent claim 9 recites that the first line switch portion and the second line switch portion of the switch assembly of the present invention are located in different compartments. Such compartments are not disclosed whatsoever neither in the Yang or Gershen references.

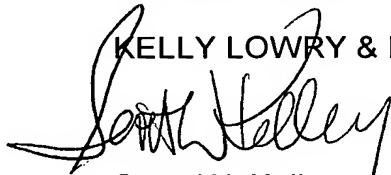
Independent claim 10 originally recited the compartments. It has been amended to include the magnetic induction shield between the first line switch portion and second line switch portion of the compartment for preventing magnetic induction of current. As discussed above, neither Yang nor Gershen disclose these elements.

Independent claim 16 has been amended to include the recitation of magnetically shielding the first line switch from the second line switch. Neither Yang nor Gershen disclose such a step.

Accordingly, Yang and Gershen fail to teach or suggest all of the claim limitations of the amended independent claims. Thus, in light of the claim amendments, Yang and Gershen fail to render these claims obvious. Of course, if an independent claim is non-obvious and patentable, its dependent claims are also non-obvious and patentable. Accordingly Applicant respectfully asserts that all of the currently pending claims, 1, 3-10, 12-16 and 18-19 are in condition for allowance, notice of which is herein respectfully requested.

Respectfully submitted,

KELLY LOWRY & KELLEY, LLP



Scott W. Kelley
Registration No. 30,762

SWK/maf
6320 Canoga Avenue, Suite 1650
Woodland Hills, California 91367
(818) 347-7900